

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM H. HANEWINKEL III and MARK G. WILLIAMS

Appeal 2007-0324
Application 10/656,695
Technology Center 3600

Decided: August 30, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and JENNIFER
D. BAHR, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

William H. Hanewinkel III and Mark G. Williams (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 5, and 28. Claims 2, 3, 6-12, 14-20, and 23-27 stand allowed. No other claims

are pending. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

Appellants' claimed invention is directed to an aircraft electronics housing comprising a heat sink (Specification 1). Independent claim 1 is illustrative of the claimed invention and reads as follows:

1. An aircraft component comprising:
 - a first section adapted to be attached at an exterior surface of an aircraft to close an access opening through the exterior surface; and
 - a second section extending outward from the first section and forming at least one heat transfer surface to transfer heat from the first section to air passing by the exterior surface and second section,wherein the first and second sections are integrally formed as a one-piece member.

Appellants seek review of the Examiner's rejection of claims 1, 5, and 28 under 35 U.S.C. § 102(b) as anticipated by Reese (US 3,727,059, issued April 10, 1973).

The Examiner provides reasoning in support of the rejection in the Final Rejection (mailed December 29, 2005) and Answer (mailed July 25, 2006). Appellants present opposing arguments in the Appeal Brief (filed May 8, 2006) and Reply Brief (filed September 21, 2006).

THE ISSUES

Appellants contend that Reese does not anticipate the subject matter of claim 1 because Reese's fin plate 10 is not an "aircraft component" (App. Br. 3), because Reese does not disclose or suggest that fins 14 form a heat transfer surface to transfer heat from the first section to air passing by the

exterior of the aircraft (App. Br. 4), and because Reese does not disclose or suggest that first section (base plate 12)¹ is adapted to be attached at an exterior surface of an aircraft to close an access opening as recited in claim 1 (App. Br. 6). Appellants also argue that Reese is not analogous art (App. Br. 5). In light of these contentions, the issues with regard to the rejection of claim 1 are whether Reese meets the limitations alluded to by Appellants and whether Appellants' non-analogous art argument demonstrates the Examiner erred in rejecting claim 1 as anticipated by Reese. Claim 5 stands or falls with claim 1 (App. Br. 6).

Appellants contend that Reese lacks a perimeter flange on first section (base plate 12) as called for in claim 28 (App. Br. 7). Accordingly, our review of the rejection of claim 28 presents the additional issue of whether Reese's base plate 12 comprises a perimeter flange with fastener mounting holes therethrough, as called for in claim 28.

THE FACTS

1. Appellants' disclosed aircraft component is a heat sink member in the form of a first wall member 46 comprising a first section 62, provided with airfoil mounting holes 82, a second section 64 in the form of heat transfer fins 72 extending away from first section 62, and a third section 65 (Specification [0001], [0027], [0029], and [0044]).

¹ Reese's reference to "fins 12" and "base plate 14" (col. 4, ll. 45-46), which is inconsistent with the labeling of the fins as "14" and the base plate as "12" in Fig. 2 and with the reference to "fins 14" (col. 4, l. 50), is an evident error. We understand the Examiner's references to "first section 12" and "second section 14" (Final Rejection 2) to denote base plate 12 and fins 14, respectively.

2. As illustrated in Appellants' Figs. 5 and 6, Appellants' first section 62 is a flat plate including mounting holes 82 around the perimeter thereof.
3. Reese discloses heat dissipating fin plates 10, each comprising a base plate 12 having fins 14 permanently affixed thereto (Reese, col. 4, ll. 44-46). The fin plates are designed for detachable mounting via bolts 16 or the like onto a container for transporting radioactive materials (Reese, col. 1, ll. 7-10; col. 4, ll. 46-50) to dissipate heat emitted from the radioactive materials during transport (Reese, col. 1, ll. 20-23). As illustrated in Fig. 2, Reese's base plate 12 and fins 14 are integrally formed as a one-piece member.
4. Reese's fins dissipate heat emitted by the contained radioactive materials (Reese, col. 1, ll. 45-46; col. 2, ll. 20-21, 31-33, and 47-50). A person of ordinary skill in the art of heat transfer would understand that the fins 14 dissipate heat conducted to them from base plate 12 to the air surrounding the fins by convection, radiation and conduction.
5. Although Reese does not explicitly mention holes, one of ordinary skill in the art would readily understand that bolts 16 pass through mounting holes in the ends of the base plate 12.
6. Reese's base plate 12 appears reasonably capable of being attached to an exterior surface of an aircraft to close an access opening through the exterior surface and Appellants have not presented any evidence or explanation that it is not so capable.

DISCUSSION

The question whether a reference is analogous art is irrelevant to whether that reference anticipates. To the contrary, a reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims.

State Contracting & Eng'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (citations omitted) (quoting *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997)). Appellants' argument that Reese is not analogous art to Appellants' invention, therefore, is clearly not relevant to whether Reese anticipates the subject matter of Appellants' claims and, consequently, does not demonstrate error in the Examiner's rejection of claims 1, 5, and 28 as anticipated by Reese.

We turn our attention next to Appellants' argument that Reese's fin plate 10 is not an "aircraft component." Appellants' disclosed aircraft component is a heat sink member comprising a flat plate with a plurality of heat dissipating fins extending outwardly from the plate (Facts 1 and 2), thereby establishing that a heat sink member is an "aircraft component," that is, a component capable of use on an aircraft. In light of Appellants' disclosure, Appellants' position that Reese's heat dissipating fin plate 10, comprising a flat base plate 12 having fins 14 extending outwardly therefrom (Fact 3), is not an "aircraft component" is not well taken.

Reese's base plate 12 appears reasonably capable of being attached to an exterior surface of an aircraft to close an access opening through the

exterior surface, and in fact appears to be so adapted in much the same manner as Appellants' first section 62 by means of bolts 16 (Facts 2, 3, 5, and 6). Reese thus reasonably supports the Examiner's determination that Reese's base plate 12 meets the limitation "a first section adapted to be attached at an exterior surface of an aircraft to close an access opening through the exterior surface" so as to shift the burden to Appellants to prove that it is not so adapted. *See In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Appellants have not met this burden by coming forth with any evidence or explanation to show that this is not the case (Fact 6). That Reese does not teach or suggest such attachment of the fin plate 10 to the exterior of an aircraft is of no moment, as claims 1, 5, and 28 do not positively recite such attachment. It is well established that limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

Appellants' argument that Reese does not disclose or suggest that fins 14 form a heat transfer surface to transfer heat from the base plate 12 to air passing by the exterior surface of an aircraft is equally unsound. It is quite clear from Reese's disclosure that the purpose of fins 14 is to dissipate heat transferred via base 12 to the air surrounding the fins (Fact 4). It follows that the fins 14 form a heat transfer surface equally capable of transferring heat to air passing over it and any surface to which base plate 12 is attached, including the exterior surface of an aircraft. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. *Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431. Therefore, that Reese does not teach or suggest such use of the fin plates 10 is of no relevance, as claims 1, 5, and 28 are directed to the heat dissipation

member only and not to its combination with an aircraft or to a method of attaching it to the exterior surface of an aircraft.

For the above reasons, we conclude that Appellants have not demonstrated error in the Examiner's rejection of claims 1 and 5 as anticipated by Reese. The rejection is sustained as to these claims.

One of ordinary skill in the art would understand from Reese's disclosure of bolts 16 passing through base plate 12 that base plate 12 is provided with mounting holes therethrough at its ends (Facts 3 and 5). As the ends are on the perimeter of base plate 12, Reese's base plate 12 comprises a perimeter flange with fastener mounting holes therethrough, as called for in claim 28. The rejection is sustained as to claim 28.

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SUMMARY

The decision of the Examiner to reject claims 1, 5, and 28 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

JRG

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